

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD W. DeMOORE and HOWARD C. SECOR

Appeal No. 1998-1435
Application No. 08/132,584

ON BRIEF

Before HAIRSTON, KRASS, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 27-36. We affirm-in-part.

BACKGROUND

The invention at issue in this appeal relates to a sheet-fed, rotary offset printing press. In such a press, the presence of a layer of moist air that clings to the surface of a freshly printed sheet reduces the quality of printed images.

The inventive dryer uses heated, high velocity jets of air to scrub and break up the moist air layer. More specifically, high velocity air is heated as it flows along a resistance heating element within an air delivery baffle tube. Once heated, the air pressurizes a plenum chamber within an air distribution manifold. High velocity jets of the hot air are then discharged through multiple air flow apertures onto the wet ink side of a printed sheet as it moves through the dryer's exposure zone. An extractor removes the moist air layer and high velocity hot air from the printed sheet and exhausts it from the press.

Claim 31, which is representative for our purposes, follows:

31. A method for drying a freshly printed sheet in a printing press comprising the steps:
installing first and second dryer heads in side-by-side relation on the press in a position facing a dryer exposure zone, the dryer heads being separated from each other by a longitudinal air gap;
discharging heated, pressurized air from each dryer head through the dryer exposure zone and onto the freshly printed sheet; and
extracting the heated air from the exposure zone through the longitudinal air gap.

The references relied on in rejecting the claims follow:

Halley 1960	2,941,062	June 14,
Henricks 1984	4,475,294	Oct. 9,
Bird 1989.	4,841,903	June 27,

Claims 27-36 stand rejected under 35 U.S.C. § 103 as obvious over Bird in view of Halley and Henricks. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the briefs¹ and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 27-30. We are also

¹We rely on and refer to the corrected appeal brief, (Paper No. 18), in lieu of the original appeal brief, (Paper No. 16), because the latter was defective. (Paper No. 17.)

persuaded, however, that he did not err in rejecting claims 31-36. Accordingly, we affirm-in-part.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these principles in mind, we address the nonobviousness of claims 27-30 and the obviousness of claims 31-36.

Nonobviousness of Claims 27-30

The appellants argue, "According to Halley, the heated air is discharged immediately out of the dryer head through

the elongated slots 3a and 4c. In contrast, Appellants' claim 27 requires pressurizing the surrounding air distribution plenum chamber with the heated air" (Appeal Br. at 7.) The examiner answers, "the broad steps of drying a freshly printed sheet including directing high velocity pressured air to an exposure zone, heating the air, discharging the heated air through rows of multiple outlet apertures via a tube and a plenum chamber are obvious in view of the teachings of Halley." (Examiner's Answer at 5.)

"`[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)).

Here, claims 27-30 each specify in pertinent part the following limitations: "heating high velocity air flowing

through the air delivery tube by heat transfer contact with an elongated heating element disposed within the air delivery tube; pressurizing the air distribution plenum chamber with the heated air" Accordingly, the claims each require heating air before the air is pressurized.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the

teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, although Halley teaches heating air, the air is not heated before it is pressurized. To the contrary, the examiner admits that the reference heats the air after it has been pressurized. He specifically admits, "[i]n Halley, Figs. 1 and 2, an elongated air delivery tube (B) deliveries **pressured** air to the plenum chamber through inlet ports 6b and the heating elements 7 are contained in the inner airflow passage (C) for heating air discharged through ports 3a." (Examiner's Answer at 5 (emphasis added).) For its part, the reference teaches heating air that has already been compressed. Specifically, "three electrical resistance elements 7 ... are adapted to heat the compressed air passing through the plenum chamber C." Col. 1, l. 70 - col. 2, l. 1.²

²We see no inconsistency between this conclusion and the rule that the U.S. Patent and Trademark Office (PTO) should give claims their broadest reasonable interpretation during prosecution. "The operative word is *reasonable*: the PTO has

The examiner fails to allege, let alone show, that Bird or Henricks remedies the defects of Halley.

Because the examiner admits that Halley heats air that has already been pressurized and the reference teaches heating air that has already been compressed, we are not persuaded that teachings from the prior art would appear to have suggested the limitations of "heating high velocity air flowing through the air delivery tube by heat transfer contact with an elongated heating element disposed within the air delivery tube; pressurizing the air distribution plenum chamber with the heated air" The examiner fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 27-30 as obvious over Bird in view of Halley and Henricks. Next, and last, we address the obviousness of claims 31-36.

Obviousness of Claims 31-36

no such obligation regarding *unreasonable* interpretations." Genentech, Inc. v. Wellcome Found. Ltd., 29 F.3d 1555, 1564 n.22, 31 USPQ2d 1161, 1168 n.22 (Fed. Cir. 1994).

We begin by finding that the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

We next note that when the appeal brief was filed, 37 C.F.R. § 1.192(c)(7)(1996) included the following provisions.

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and ... appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument ... why the claims are separately patentable.

In general, claims that are not argued separately stand or fall together. In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983). When the patentability of dependent claims in particular is not argued separately, the claims stand or fall with the claims from which they depend. In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Here, the patentability of dependent claims 32-36 is not argued separately from independent claim 31. To the contrary, the appellants state, "the appealed claims are mutually related and fall within a single grouping of claims." (Appeal Br. at 5.) Therefore, we consider claims 31-36 to stand or

fall together as a group. We select claim 31 to represent the group. With this representation in mind, we address the appellants' argument and the examiner's answer.

The appellants make the following argument.

As can be seen in Figure 1 of the Bird patent, the discharge of the elements 27 and 26 is perhaps 120° apart, and, assuming arguendo, that a "gap" is defined therebetween in that 120°, the device 28 is, in fact, on the opposite side of devices 26 and 27 from the "gap." To argue that a "gap" exists in the perhaps 240° separation between the discharge of the two devices 26 and 27 in which device 28 is located stretches the meaning of the word too far to be reasonable.

(Reply Br. at 2.) The examiner's answer follows.

Bird (Fig.1) teaches that the first dryer head 27 and second dryer head 26 are positioned side by side in the press and the dryer heads are separated by the longitudinal air gap between the heads, discharging heated, pressurized air onto the freshly printed sheet and extracting (vapor-extraction unit 28) the heated air from the longitudinal air gap exposed to the heating zone.

(Examiner's Answer at 5-6.)

"In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover, limitations are not to be read into the claims from the

specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)(citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, representative claim 31 specifies in pertinent part the following limitations: "installing first and second dryer heads in side-by-side relation on the press in a position facing a dryer exposure zone, the dryer heads being separated from each other by a longitudinal air gap ... extracting the heated air from the exposure zone through the longitudinal air gap." Giving the claim its broadest reasonable interpretation, the limitations recite extracting heated air through a gap between a pair of dryer heads.

The examiner shows that the prior art would have suggested the limitations. "[A] disclosure that anticipates under Section 102 also renders the claim invalid under Section 103, for 'anticipation is the epitome of obviousness.'" Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (quoting In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982)). In other words, obviousness follows ipso facto from an anticipatory reference. RCA Corp.

V. Applied Digital Data Sys, Inc., 730 F.2d 1440, 1446, 221
USPQ 385, 390 (Fed. Cir. 1984).

Here, Bird teaches a "first drying interstation **25**, comprising a pair of spaced, elongate air knives **26** and **27**" Col. 4, ll. 53-55. The reference further teaches that the air knives are dryer heads. Specifically, "[s]ubstantial drying is produced by the first air knife **26**, and the second air knife **27** preferably is included, as illustrated, to insure complete drying" Col. 5, ll. 8-10. Figure 1 of Bird, moreover, shows that the air knives are separated by an air gap.

The reference teaches that the first drying interstation also includes "a vapor-extraction unit **28** containing an intake fan and a [sic] outlet conduit **29** which conveys the volatile vehicle vapors to a recovery unit, to the atmosphere or for **30** other safe disposal." Col. 4, ll. 55-58. Bird describes the extraction of heated air by the vapor extraction unit as follows.

Knives **26** and **27** are elongate tubular elements provided with an elongate narrow

slot Heated air is circulated through the tubular elements under pressure and is expelled from the elongate slot as a concentrated narrow band of high speed hot air which is directed against the ink-printed copy sheets **18A** to evaporate the volatile solvent and water therefrom to release solvent and water vapor which is withdrawn by the extraction unit **28**.

Col. 4, l. 67 - col. 5, l. 8. Figure 1 of the reference shows that the vapor extraction unit is positioned directly above the air gap between the air knives. Because of this positioning, the vapor extraction unit would necessarily extract heated air through the air gap.

Because Bird's vapor extraction unit would extract heated air through the gap between its air knives, we are persuaded that these teaching would have suggested ipso facto the limitations of "installing first and second dryer heads in side-by-side relation on the press in a position facing a dryer exposure zone, the dryer heads being separated from each other by a longitudinal air gap ... extracting the heated air from the exposure zone through the longitudinal air gap." Therefore, we affirm the rejection of claims 31-36 as obvious over Bird in view of Halley and Henricks. Our affirmance is

based only on the arguments made in the briefs. Arguments not made therein are not before us, are not at issue, and are considered waived.

CONCLUSION

In summary, the rejection of claims 27-30 under 35 U.S.C. § 103 as obvious over Bird in view of Halley and Henricks is reversed. The rejection of claims 31-36 under 35 U.S.C. § 103 as obvious over Bird in view of Halley and Henricks, however, is affirmed.

No time for taking any subsequent action in connection
with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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LOCKE, PURNELL, RAIN, HARREL, P.C.
ATT: INTELLECTUAL PROPERTY SECTION
2200 ROSS AVENUE
STE. 2200
DALLAS, TX 75201

BARRY

APPEAL NO. 1998-1435 - JUDGE

APPLICATION NO. 08/132,584

APJ BARRY - 2 copies

APJ HAIRSTON

APJ KRASS

DECISION: **AFFIRMED-IN-PART**

Prepared By: APJ BARRY

DRAFT SUBMITTED: 03 Oct 01

FINAL TYPED:

Team 3:

I have typed almost all of this opinion.

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